



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,491	09/15/1999	STANISLAV KHIRMAN	NARSP003	8814

758 7590 05/11/2004

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/397,491

Applicant(s)

KHIRMAN ET AL.

Examiner

George C Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 43-48 have been added. Claims 29-48 are pending and have been examined.

Response to Arguments

2. Applicant's arguments filed 23 February 2004 have been fully considered but they are not persuasive.

In regards to Applicant's argument that Oliver teaches away from the claimed invention, the Examiner points out that Oliver teaches another way by disclosing how the method of allowing the plurality of request signals to pass uninterrupted between a first device and a second device in response to an operational failure within a detector device or "CALS" is an improvement over the prior art where the invention is designed to accommodate the failure of a detector device or "CALS" wherein the second device or "CPM" is permitted to request signals to pass uninterrupted between the first and second devices or "serve resources" in order for the "CPM" to continue to reply affirmatively to requests from the first device or "CM". (page 114, paragraph 327). Oliver also discloses the invention (page 14, lines 1-5 of paragraph 327). It has been held that "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." See *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

3. In response to applicant's arguments, the recitation "the detector device is coupled to the network between a first device and a second device" has not been given

Art Unit: 2143

patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Even if the limitation may be considered to have patentable weight, the limitation would not distinguish the invention in terms of patentability. The word "between" may be construed as to "linking" or "connecting" the elements, which would exemplify a "network" as is commonly known to those skilled in the art, therefore, Oliver would anticipate this structural limitation as shown in Figure 2.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29-30, 36, 38, and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by OLIVER et al [US Patent Application Publication 20020133412 A1].

Regarding claim 29, OLIVER discloses a method for use in a detector device for controlling access to information on a network including a plurality of interconnected

Art Unit: 2143

devices, the detector device coupled to the network between a first device and a second device, the method comprising:

monitoring a plurality of request signals for data between the first device and the second device in the network, at least one request signal including a user identification parameter; determining whether a user identified by the user identification parameter in the request signal is permitted access to the data; comparing a predetermined parameter associated with the user with a predetermined value parameter associated with the data to determine permission to access the data; and in response to the comparison, providing a response to the request signal; and in response to an operational failure within the detector device, allowing the plurality of request signals to pass uninterrupted between the first device and the second device. [Figure 2, note items "CM", "CALS", and "CPM" wherein "CM" is the "user" of the "first device", the "CALS" is the "detector device", and the CSP is the "second device"; paragraphs 270-294, 308, and 326-333, especially paragraph 327; paragraphs 341-347, specifically paragraphs 343 and 344]

Claims 36, 42, and 43 are also rejected under 35 USC 102(e) since claims 36, 42, and 43 contain the same limitations as recited in claim 29.

Regarding claim 30, OLIVER discloses a method of controlling access of claim 29, wherein the provided response comprises allowing access to the data when the predetermined parameter associated with the user is greater than or equal to a predetermined value parameter associated with the data. [paragraph 332]

Claims 38 and 44 are also rejected under 35 USC 102(e) since claims 38 and 44 contain the same limitations as recited in claim 30.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 31-32, 35, 37, 39-40, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over OLIVER et al. in view of Iwamura [US Patent 6 272 535 B1].

Regarding claim 31, OLIVER discloses a method of controlling access of claim 29.

OLIVER does not expressly disclose wherein the provided response comprises allowing access to the data when the predetermined parameter associated with the user is less than or equal to a predetermined parameter associated with the data, however, Iwamura does disclose these limitations [column 20, lines 62-67]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow access to the data when the predetermined associated with the user is less than or equal to a predetermined parameter associated with the data because since Iwamura discloses that these limitations allow a user to access low quality information for the purposes of advertisement only [column 20, lines 62-67], one of ordinary skill would have known that users are willing to accept lower quality services for a reduced or no charge and would have combined these teachings with the method of controlling access in order to provide a choice of quality in services to the user.

Claims 35 and 45 are also rejected under 35 USC 103(a) since claims 35 and 45 are subject to the same references applied to claim 31 and motivations regarding the obviousness of claim 31.

Claim 37 is also rejected under 35 USC 103(a) since claim 37 contains the same limitations as recited in claim 31.

Claim 40 is also rejected under 35 USC 103(a) since claim 40 contains the same limitations as recited in claim 35.

Regarding claim 32, OLIVER discloses the method of claim 29.

OLIVER does not expressly disclose wherein the provided response comprises re-directing the data signal to a third device in response to the predetermined parameter associated with the user being less than the predetermined value associated with the data, the third device allowing for a re-setting of the predetermined parameter to a new parameter comprising a value greater than or equal to the predetermined value

Art Unit: 2143

parameter associated with the data, however, Iwamura does disclose these limitations [column 6, lines 20-30].

Iwamura discloses that these limitations allow a user to quickly and efficiently re-set a predetermined parameter associated with the user to a new parameter comprising a value greater than or equal to a predetermined value parameter associated with the data [column 6, lines 20-30, specifically lines 27-30]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a user to re-set the predetermined parameter associated with the user to a new parameter comprising a value greater than or equal to the predetermined value parameter associated with the data because one of ordinary skill would appreciate the advantage of being able to quickly and efficiently re-set the predetermined parameter associated with the user without having to do so at another location and would have combined the teachings of both references in order to achieve a more time-efficient invention as claimed.

Claims 39 and 46 are also rejected under 35 USC 103(a) since claims 39 and 46 contain the same limitations as recited in claim 32.

6. Claims 33, 34, 41, and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over OLIVER et al. in view of Lyles et al. [US Patent 5 917 822 A] and in further view of Houston [US Patent 6 353 929 B1].

Regarding claim 33, OLIVER discloses the method of claim 29.

Art Unit: 2143

OLIVER discloses wherein the predetermined parameter is one from a group comprising a positive monetary value and a positive time value. [paragraphs 120 and 330-333]

OLIVER does not expressly disclose a bandwidth value and a quality of service value, however, Lyles discloses that bandwidth and quality of service values in the context of providing user specific services based on threshold values such as bandwidth and quality of service is well known and used in the art [column 1, line 66-column 4, line 56; column 5, line 8-column 6, line 26], therefore, one of ordinary skill in the art would have known to combine the teachings of these references to achieve the invention as claimed.

OLIVER and Lyles do not expressly disclose a content rating, however, Houston discloses that using content ratings in the context of providing user specific services based on threshold values such as content ratings is well known and used in the art [column 2, lines 27-40], therefore, one of ordinary skill in the art would have known to combine the teachings of these references to achieve the invention as claimed.

Claims 41 and 47 are also rejected under 35 USC 103(a) since claims 41 and 47 contain the same limitations as recited in claim 33.

Regarding claim 34, OLIVER, Lyles, and Houston disclose the method of claim 33.

OLIVER does not expressly disclose allowing access to one from a group comprised of voice data, video data, and a real-time application in response to at least one of the bandwidth value or quality of service value being greater than or equal to a

Art Unit: 2143

threshold parameter, however, Lyles discloses that these limitations in the context of providing user specific services based on threshold values such as bandwidth and quality of service is well known and used in the art [column 1, line 66-column 4, line 56; column 5, line 8-column 6, line 26, specifically column 5, lines 24-43 and column 5, line 62-column 6, line 7], therefore, one of ordinary skill in the art would have known to combine the teachings of these references to achieve the invention as claimed.

Claim 48 is also rejected under 35 USC 103(a) since claim 48 contains the same limitations as recited in claim 34.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is

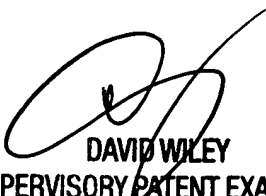
Art Unit: 2143

703-305-4565. The examiner can normally be reached on Monday-Saturday 5:30am-10pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100